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EXAMINER	
MILIA, MARK R	
ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/536,749	ONUMA, MAKI	
	Examiner	Art Unit	
	Mark R. Milia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-7 and 9-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-7 and 9-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 May 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. Figure 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference numeral **40** is mentioned on page 8, line 16 of the specification relating to Fig. 1 but does not appear in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In Fig. 1, reference numeral **17**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document No. 11-187212 to Yoshikawa, as cited in the IDS dated 9/16/06, reference will be made to a computer translation that is hereby attached to this Office Action, in view of U.S. Patent No. 6,975,435 to Maitani et al.

Regarding claim 1, Yoshikawa discloses an image printing and reading apparatus comprising: a printing unit to print an image on a print sheet conveyed through a print sheet path (see paragraphs 11, 13 line 2, and 27), a reading unit to read a document conveyed through a document path, having a common part belonging to said print sheet path and said document path (see paragraphs 31 and 33), a reference white board for shading correction used by said reading unit (see paragraphs 37 line 6-9 and 39), and a moving unit to move said reading unit and said reference white board to a document reading position when said reading unit executes document reading, on the other hand, to move said reading unit and said reference white board to a retreat position in which the influence of ambient light is reduced (see paragraphs 8-9, 29, 34-35, 40-41, and 45-46, reference shows that the reading unit and the white board move between a home position and a reading position based on whether reading or recording is taking place).

Yoshikawa does not disclose expressly prescanning.

Maitani discloses a reference white board for shading correction used by said reading unit upon execution of prescanning (see Fig. 4, column 7 lines 35-37, and column 9 lines 17-27) and wherein said reading unit and said reference white board are

in a position in which the influence of ambient light is reduced at least upon execution of prescanning (see column 9 lines 17-49).

Regarding claim 6, Yoshikawa discloses a scanning method in an image printing and reading apparatus including: a printing unit to print an image on a print sheet conveyed through a print sheet path (see paragraphs 11, 13 line 2, and 27), a reading unit to read a document conveyed through a document path, having a common part belonging to said print sheet path and said document path (see paragraphs 31 and 33), and a reference white board for shading correction used by said reading unit (see paragraph 37 line 6-9), said method comprising: a step of moving said reading unit and said reference white board to a document reading position when said reading unit executes document reading, on the other hand, to move said reading unit and said reference white board to a retreat position in which the influence of ambient light is reduced (see paragraphs 8-9, 29, 34-35, 40-41, and 45-46, reference shows that the reading unit and the white board move between a home position and a reading position based on whether reading or recording is taking place).

Yoshikawa does not disclose expressly prescanning.

Maitani discloses a reference white board for shading correction used by said reading unit upon execution of prescanning (see Fig. 4, column 7 lines 35-37, and column 9 lines 17-27), wherein said reading unit and said reference white board are in a position in which the influence of ambient light is reduced at least upon execution of prescanning (see column 9 lines 17-49), and a step of executing the prescanning when

said reading unit and said reference white board are in said retreat position (see column 9 lines 17-27).

Yoshikawa & Maitani are combinable because they are from the same field of endeavor, a combination printing and scanning device utilizing a reference white board for correction of light quantity.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the prescanning, as described by Maitani, with the system of Yoshikawa.

The suggestion/motivation for doing so would have been to provide a basis or initial value based on a white reference board (prescanning) to provide a more accurate shading correction as the light source is moved to read the document.

Therefore, it would have been obvious to combine Maitani with Yoshikawa to obtain the invention as specified in claims 1 and 6.

Regarding claims 2 and 7, Yoshikawa further discloses wherein said retreat position is a position within a casing of said image printing and reading apparatus and away from said document reading position (see paragraphs 8-9).

6. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa in view of Maitani and further in view of U.S. Patent No. 5,528,788 to Yamamoto et al.

Regarding claim 10, Yoshikawa discloses an image printing and reading apparatus comprising: a printing unit to print an image on a print sheet conveyed through a print sheet path (see paragraphs 11, 13 line 2, and 27), a reading unit to read a document conveyed through a document path, having a common part belonging to said print sheet path and said document path (see paragraphs 31 and 33), a reference white board for shading correction used by said reading unit (see paragraph 37 line 6-9), a moving unit to move said reading unit and said reference white board to a document reading position when said reading unit executes document reading, on the other hand, to move said reading unit and said reference white board in a direction deviated from a color material discharging direction at least when said printing unit executes printing (see paragraphs 8-9, 29, 34-35, 40-41, and 45-46, reference shows that the reading unit and the white board move between a home position and a reading position based on whether reading or recording is taking place).

Yoshikawa does not disclose expressly prescanning and a detection unit to detect occurrence of jam in the common path belonging to said print sheet path and said document path, wherein if said detection unit has not detected the occurrence of jam, said reading unit executes the prescanning.

Maitani discloses a reference white board for shading correction used by said reading unit upon execution of prescanning (see Fig. 4, column 7 lines 35-37, and column 9 lines 17-27), and executing the prescanning when no occurrence of a jam has taken place (see column 9 lines 17-27).

Yamamoto discloses a detection unit to detect occurrence of jam in the common path belonging to said print sheet path and said document path; wherein if said detection unit has not detected the occurrence of jam, said reading unit executes (see column 7 line 13-column 8 line 6).

Regarding claim 11, Yoshikawa discloses a prescanning image in an image printing and reading apparatus including: a printing unit to print an image on a print sheet conveyed through a print sheet path (see paragraphs 11, 13 line 2, and 27), a reading unit to read a document conveyed through a document path, having a common part belonging to said print sheet path and said document path (see paragraphs 31 and 33), a reference white board for shading correction used by said reading unit (see paragraph 37 line 6-9), said method comprising; a step of moving said reading unit and said reference white board to a document reading position when said reading unit executes document reading, on the other hand, moving said reading unit and said reference white board in a direction deviated from a color material discharging direction at least when said printing unit executes printing (see paragraphs 8-9, 29, 34-35, 40-41, and 45-46, reference shows that the reading unit and the white board move between a home position and a reading position based on whether reading or recording is taking place).

Yoshikawa does not disclose expressly prescanning and a step of performing the prescanning when said reading unit and said reference white board are in said retreat position, and a step of detecting occurrence of jam in the common path belonging to

said print sheet path and said document path, wherein if the occurrence of jam has not been detected, the prescanning is executed.

Maitani discloses a reference white board for shading correction used by said reading unit upon execution of prescanning (see Fig. 4, column 7 lines 35-37, and column 9 lines 17-27), a step of executing the prescanning when said reading unit and said reference white board are in said retreat position (see column 9 lines 17-27), and executing the prescanning when no occurrence of a jam has taken place (see column 9 lines 17-27).

Yamamoto discloses a step of detecting occurrence of jam in the common path belonging to said print sheet path and said document path, wherein if the occurrence of jam has not been detected, the scanning is executed (see column 7 line 13-column 8 line 6).

Yoshikawa, Maitani, & Yamamoto are combinable because they are from the same field of endeavor, combination printing and scanning devices.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the detection of a paper jam, as described by Yamamoto and which is well known and commonly used in the art, the prescanning, as described by Maitani, with the system of Yoshikawa.

The suggestion/motivation for doing so would have been to ensure system efficiency operability by detecting paper jams and to provide a basis or initial value to allow proper shading correction as the light source is moved to read the document.

Therefore, it would have been obvious to combine Yamamoto and Maitani with Yoshikawa to obtain the invention as specified in claims 10-11.

7. Claims 5, 9, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa and Maitani as applied to claims 1, 2, 6, and 7 above, and further in view of Yamamoto.

Maitani discloses executing the prescanning when no occurrence of a jam has taken place (see column 9 lines 17-27).

Yoshikawa and Maitani does not disclose expressly a detection unit to detect occurrence of jam in the common path belonging to said print sheet path and said document path.

Yamamoto discloses a detection unit to detect occurrence of jam in the common path belonging to said print sheet path and said document path, wherein if said detection unit has not detected the occurrence of jam, said reading unit executes (see column 7 line 13-column 8 line 6).

Yoshikawa, Maitani, & Yamamoto are combinable because they are from the same field of endeavor, combination printing and scanning devices.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the detection of a paper jam, as described by Yamamoto and which is well known and commonly used in the art, with the system of Yoshikawa and Maitani.

The suggestion/motivation for doing so would have been to ensure system efficiency operability by detecting paper jams and to provide a basis or initial value to allow proper shading correction as the light source is moved to read the document.

Therefore, it would have been obvious to combine Yamamoto with Yoshikawa and Maitani to obtain the invention as specified in claims 5, 9, 12, and 13.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art please refer to the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571)272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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